

TTAB

Alliance of Professionals and Consultants, Inc.  
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April 16, 2012

**Via Express Mail**

**(Post Office to Addressee)**

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

85/211,681

Re: Academy of Motion Picture Arts and Sciences v. Alliance of Professionals and Consultants, Inc. (Cancellation No. 92055081)/Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Dismiss

Dear Sir or Madame:

Please find enclosed (1) an original of Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Dismiss, and (2) a self-addressed, stamped, post card.

Please file stamp both documents, file the Reply, and mail the file stamped post card to me. If you have any questions or concerns, please contact me at your convenience.

Sincerely,

John Roseboro

Encls. (2 as stated in text)



04-17-2012

U.S. Patent & TMO/TM Mail Rept. Dt: #01



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,974,726

Registered June 7, 2011

Mark: OSCAR

ACADEMY OF MOTION PICTURE )  
ARTS AND SCIENCES, )

Cancellation No. 92055081

Petitioner, )

v. )

**RESPONDENT'S REPLY TO PETITIONER'S**

**OPPOSITION TO RESPONDENT'S**

**MOTION TO DISMISS**

ALLIANCE OF PROFESSIONALS & )  
CONSULTANTS, INC. )

Respondent. )

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TO THE COMMISSIONER FOR TRADEMARKS:

NOW COMES Respondent, Alliance of Professionals & Consultants, Inc. ("Respondent APC"), pursuant to § 502.02(b) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), replying to Petitioner's Opposition to Respondent's Motion to Dismiss as follows.

**Argument**

- A. Absent Legislative History that Explains Why the U.S. Senate Amended Section 43(c)(6) of the Lanham Act to Bar Federal Dilution Claims, It is Speculative to Conclude that the Amendment was a Drafting Error.**

The plain and unambiguous language of Section 43(c)(6) of the Lanham Act gives federal trademark registrants complete immunity from liability for dilution claims. See 15 U.S.C. § 1125(c)(6). Despite the plain and unambiguous language of the statute, Petitioner urges this tribunal to construe the statute as providing a different, narrower defense. Petitioner

contends that Section 43(c)(6) should be construed as only barring dilution claims that are based on state law. (See Pet'r Opposition to Resp't Mot. to Dismiss pp. 6-11). To support its contention, Petitioner argues that the statute's legislative history indicates that Congress only intended for there to be a bar against state law dilution claims and the amendment that expands the scope of the bar to include federal law dilution claims was a drafting error. (See *id.*). The fallacy with Petitioner's argument is that it is based on legislative history that is silent about why the U.S. Senate amended Section 43(c)(6) to bar all dilution claims.

The legislative history shows that Section 43(c)(6) was part of legislation that was introduced and passed in the U.S. House of Representatives before it was sent to the U.S. Senate. See H.R. 683, 109<sup>th</sup> Cong. (2005). It was the U.S. Senate's Judiciary Committee that amended Section 43(c)(6)'s registration defense to cover all dilution claims, including federal claims. See 152 Cong. Rec. S1504 (2006); see also Timothy A. Lemper and Joshua R. Bruce, *The Dilution Defense Congress Never Meant to Create (And Needs to Fix)*, 101 The Trademark Reporter 1580, 1584-85 ("The Senate bill made virtually no change to the wording of the House bill. But by reorganizing the language as it did, the Senate Version drastically broadened the scope of the federal registration defense in the statute ... As a result, the Senate's version barred all dilution claims ... brought under state *or federal law*)(emphasis in original). There is nothing in the legislative history that explains why the Senate made the amendment to the registration defense. See 152 Cong. Rec. S1921-23 (2006); 152 Cong. Rec. H6963-65 (2006); see also Lemper and Bruce, 101 Trademark Rep. at 1585 ("...[N]othing in the .. legislative history indicates the reason for the Senate's revision to the federal registration defense ... The Senate's substitute bill was adopted by the Senate Judiciary Committee and approved by both the

Senate and the House without any testimony, discussion or written report explaining the change to the federal registration defense in Section 43(c)(6) of the Lanham Act.”). It is hazardous to attempt to gauge the legislative intent of the Senate’s amendment from silence. Petitioner’s conclusion that the amendment was a drafting error is sheer speculation.

**B. That Dilution Claims Have Been Raised in Cases After Section 43(c)(6) was Enacted is of No Consequence.**

Respondent suggests that Section 43(c)(6) does provide immunity from federal law dilution claims because such claims have been raised in cases before the Trademark Trial and Appeal Board since the statute was enacted: “Notwithstanding Respondent’s contention that dilution claims against federal trademark registrants are barred by the 2006 amendment to Section 43(c)(6) of the Lanham Act, dilution claims have been raised repeatedly in cancellation proceedings decided by the TTAB since then.” (See Pet’r Opposition to Resp’t Mot. to Dismiss p. 3 n. 4 )(citing *Outdoor Kids, Inc. v. Parris Mfg. Co.*, Cancellation Nos. 92045687 and 9204643 (T.T.A.B. Mar. 9, 2009); *Asics Corp v. Chase Ergonomics Inc.*, Cancellation no. 92043354 (T.T.A.B. Dec. 15, 2006). Petitioner’s reliance on the *Outdoor Kids, Inc.* and *Asics Corp.* cases is misplaced for at least two reasons.

First of all, the cases are not binding precedent. See *Outdoor Kids, Inc.*, slip op. at 1 (“This Opinion is Not Citable as Precedent of the T.T.A.B.”); *Asics Corp.*, slip op. at 1 (“This Opinion Is Not A Precedent of the TTAB”); TBMP § 101.03 (explaining that cases that are not designated as citable as precedent are not binding on TTAB). Secondly, the cases have no persuasive weight on the relevant issue of whether Section 43(c)(6) bars federal dilution claims because the issue was not raised in either of the cases. In *Outdoor Kids, Inc.* the dilution claim was summarily dismissed because the mark in question was not sufficiently famous. See

*Outdoor Kids, Inc.*, slip op. at 27. In *Asics Corp.*, the holding regarding the dilution claim was that summary judgment was improper on the claim because genuine issues of material fact existed. See *Asics Corp.*, slip op. at 4-5. Thus, *Asics Corp* and *Outdoor Kids, Inc.* do not support the proposition that Section 43(c)(6) does not provide immunity from federal dilution claims. Indeed, Respondent's research does not reveal (and Petitioner's opposition does not cite) a single reported opinion that does support that proposition.

### **Conclusion**

For the foregoing reasons and those explained in Respondent APC's opening motion, Respondent APC's motion to dismiss Petitioner's dilution claim should be allowed.

This the 16<sup>th</sup> day of April 2012

By:

A handwritten signature in black ink, appearing to read "John Roseboro", is written over a horizontal line.

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Attorney for Respondent Alliance of Professionals  
& Consultants, Inc.

ACADEMY OF MOTION PICTURE )  
ARTS AND SCIENCES, )  
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v. )  
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ALLIANCE OF PROFESSIONALS & )  
CONSULTANTS, INC. )  
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Respondent. )

Cancellation No. 92055081

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**CERTIFICATE OF SERVICE**

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I hereby certify that a true and complete copy of the foregoing Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Dismiss has been served on the following by mailing said copy via First Class Mail, postage prepaid, to the following:


Attorneys for Petitioner Academy of Motion Picture Arts and Sciences:

Quinn Emanuel Urquhart & Sullivan, LLP  
Claudia T. Bogdanos  
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Quinn Emanuel Urquhart & Sullivan, LLC  
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Los Angeles, CA 90017-2543

This the 16th day of April 2012.

By:

  
\_\_\_\_\_  
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Attorney for Respondent Alliance of Professionals  
& Consultants, Inc.

ACADEMY OF MOTION PICTURE )  
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CONSULTANTS, INC. )  
 )  
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Cancellation No. 92055081

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**CERTIFICATE OF MAILING**


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I hereby certify that this Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Dismiss is being deposited in the United States Postal Service, with sufficient postage as Express Mail via the "Express Mail Post Office to Addressee" service, in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

This 16<sup>th</sup> day of April 2012

By:

  
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